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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/589,313

06/16/2009

Renaud Moliton

979-243

8384

39600

7590

04/19/2011

SOFER & HAROUN LLP.

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NEW YORK, NY 10017

EXAMINER

SCHWARTZ, JORDAN MARC

ART UNIT

PAPER NUMBER

2873

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/589,313	Applicant(s) MOLITON ET AL.	
	Examiner Jordan M. Schwartz	Art Unit 2873	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 February 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 7 is/are rejected.
- 7) ☒ Claim(s) 3-6 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Oath/Declaration

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because it incorrectly states that priority has not been claimed for foreign application Fr 0450294. This contradicts the first paragraph of the specification in which it is stated that priority has been claimed as to this foreign application. It is not clear if applicant is claiming priority or not claiming priority. Presumably the declaration is in error and therefore a corrected declaration is required.

This issue was raised in the prior office action and still needs to be addressed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Morris et al patent number 5,384,607.

Morris et al discloses the limitations therein including the following: a display (fig 6, the entire optical system providing optical information to the eye i.e. “displaying information” and being considered as a “display”). Regardless, the claimed “display” is set forth in the preamble and need not be given patentable weight. Morris further discloses the apparatus comprising an ophthalmic spectacle lens (abstract, fig 6, the

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spectacle lens portion); an optical imager for shaping light beams and directing them towards the eye of the wearer (abstract, fig 6, column 6, lines 27-44, the telescope assembly "10" as the "optical imager" i.e. being a telescope it forms optical images by shaping light beams and directing them towards the eye of the wearer); to enable information content to be viewed (abstract, fig 6, column 6, lines 27-44, i.e. a telescope will provide information of the object being viewed i.e. "enable information content to be viewed"); the optical imager being secured to the ophthalmic spectacle lens (fig 6, column 12, line 63 to column 13, line 11); the spectacle lens having markings for referencing the position of the imager relative to the spectacle lens (column 3, line 33, column 7, lines 56-61); in order to secure the imager on the ophthalmic spectacle lens (fig 6, column 3, line 33, column 7, lines 56-61, the lens is marked so that the imager is properly located with respect to the lens and then secured similar to applicant's disclosure i.e. "in order to correctly secure the imager on the lens"). The assembly of Morris is being used to provide telescopic viewing for each eye and therefore will inherently be positioned to be centered on the eye i.e. "markings to allow positioning relative to a virtual theoretical center of the eye". Morris further discloses securing means enabling the imager to be put in position in compliance with the position indicated by the markings (column 7, lines 56-61, column 12, line 63 to column 13, line 11).

Claims 1-2 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Karasawa patent number 5,739,797.

Karasawa discloses the limitations therein including the following: a display (abstract, figs 1, 18 and 27); comprising an ophthalmic spectacle lens (figs 1, 18 and 27, column 11, line 56, the spectacle lens portion); an optical imager for shaping light beams and directing them towards the eye of the wearer (abstract, figs 1, 18 and 27, the image display element); to enable information content to be viewed (abstract, column 1, lines 8-13); the optical imager being secured to the ophthalmic spectacle lens (figs 1, 18 and 27); the spectacle lens having markings for referencing the position of the imager relative to the spectacle lens (column 7, lines 44-56, column 11, lines 46-59, i.e. lens markings to denote the center location in order to properly align the image display device); in order to secure the imager on the ophthalmic spectacle lens (figs 1, 18, 27, column 7, lines 44-56, column 11, lines 46-59, the lens is marked so that the imager is properly located with respect to the lens and then secured similar to applicant's disclosure i.e. "in order to correctly secure the imager on the lens"). The assembly of Karasawa is being used to provide electronic image information to an eye and therefore will inherently be positioned to be centered on the eye i.e. "markings to allow positioning relative to a virtual theoretical center of the eye". Keresawa further discloses securing means enabling the imager to be put in position in compliance with the position indicated by the markings (figs 1, 18, 27, column 7, lines 44-56, column 11, lines 46-59).

Prior Art Citations

For applicant's information, Perera patent number 4,867,551 together with Morris et al patent number 5,384,607 as a teaching reference would have made obvious

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claims 1-2 and 7, however, such rejections would have been repetitive. Specifically, Perera discloses a display device comprising spectacles with an optical imager attached to its face but does not specifically disclose the reference marks for positioning. Morris teaches that in an optical device comprising spectacles and having an imaging apparatus attached to its face that it is desirable for the lens to include markings in order to properly position the imaging apparatus in front of the spectacle lenses.

For applicant's information, Feinbloom patent number 4,364,645 is being cited herein to show an optical device that would have read on or made obvious claims 1-2 and 7, however, such rejections would have been repetitive.

Response to Arguments

Applicant's amendment and arguments of February 16, 2011 with respect to the 112 rejections set forth in the prior office action were persuasive. Additionally, the amendments to the claims are fully supported by the specification and figures as originally presented and therefore do not present prohibited new matter. Specifically, the amendments to claim 1 are supported by at least page 2, lines 22-28 and at least page 3, line 35 of the specification. Additionally, the amendments to claims 2-6 are supported by at least page 3, lines 4-25 of the specification.

Applicant's amendments have overcome the art rejections set forth in the prior office action. However, the claims as amended are still subject to art rejections as per the rejections set forth above.

Allowable Subject Matter

Claims 3-6 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: with respect to the allowable subject matter, none of the prior art either alone or in combination disclose or teach of the claimed combination of limitations to warrant a rejection under 35 USC 102 or 103. Specifically, with respect to claims 3-5, none of the prior art either alone or in combination disclose or teach of the claimed display specifically including, as the distinguishing feature(s) in combination with the other limitations, the markings denoting the position of the far vision point and information for defining the virtual theoretical center of the eye. Specifically, with respect to claim 6, none of the prior art either alone or in combination disclose or teach of the claimed display specifically including, as the distinguishing feature(s) in combination with the other limitations, the markings including a value for the power compensation to be provided to the imager. Specifically, with respect to claim 8, none of the prior art either alone or in combination disclose or teach of the claimed display specifically including, as the distinguishing feature(s) in combination with the other limitations, the position of the imager relative to the ophthalmic spectacle lens is referenced as a function of correction parameters of the lens.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jordan M. Schwartz whose telephone number is 571-272-2337. The examiner can normally be reached on Monday to Friday from 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ricky Mack can be reached on 571-272-2333. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jordan M. Schwartz
Primary Examiner
Art Unit 2873
April 14, 2011

/Jordan M. Schwartz/
Primary Examiner, Art Unit 2873